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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,638	02/05/2004	Shinji Fujikawa	S0530.0002	4113
32172	7590	07/25/2007	EXAMINER	
DICKSTEIN SHAPIRO LLP			KASZTEJNA, MATTHEW JOHN	
1177 AVENUE OF THE AMERICAS (6TH AVENUE)			ART UNIT	PAPER NUMBER
NEW YORK, NY 10036-2714			3739	
MAIL DATE		DELIVERY MODE		
07/25/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/771,638	FUJIKAWA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Matthew J. Kasztejna	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 May 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3,5,7,9-11,13,17,19,21,23 and 24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3,5,7,9-11,13,17,19,21,23 and 24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 7/6/04 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 16, 2007 has been entered.

### ***Notice of Amendment***

In response to the amendment filed on April 13, 2007, amended claims 1-2 and new claims 23-24 are acknowledged. The following new grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 7, 9-11, 13, 17, 19, 21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,066,089 to Costello et al.

**In regards to claims 1 and 23-24,** Costello et al. disclose an endoscope apparatus comprising: an endoscope including an elongated flexible tube 1004 having flexibility such that a part of the flexible tube is inserted in at least an inspection object

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space (see Figs. 10a-b and 11a-b); an endoscope apparatus main body 106 connected to the endoscope for use; and a flexible tube holding member 180 including a tip fixing portion 182 to fix a tip of the flexible tube thereto, which is detachably attached to the endoscope apparatus main body and around which the flexible tube is wound to hold the flexible tube of which the tip is inserted in the tip fixing portion (see Fig. 1 and Col. 5, Lines 16-24 and Col. 9, Lines 10-22). Costello et al. also teaches that the insertion tube may be held in a recess of a foam insert of wedged between two foam pieces of a foam insert. Costello et al. disclose the claimed invention but does not disclose expressly that the tip-fixing portion is arranged such that it *projects* on an outer peripheral surface of a cylindrical portion. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the tip fixing portion as taught by Costello et al. with the a tip fixing portion that projects from an outer surface, because Applicant has not disclosed that the tip fixing portion projecting from an outer surface provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with tip fixing slots 182 as taught by Costello et al., because it provides the same effect of fixing the tip portion of the insertion portion on the tube holding member and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Costello et al. As shown in Figure 15a of the applicant's drawings, hole 61 is provided for insertion of the tip of the endoscope, therefore the same effect as that of the first embodiment (a protruding tip fixing portion) can also be obtained with hole

61. Therefore, it would have been an obvious matter of design choice to modify Costello et al. to obtain the invention as specified in claim 1.

**In regards to claim 2,** Costello et al. disclose endoscope apparatus wherein the flexible tube holding member is stored in a storage section 108 which is detachably attached to the endoscope apparatus main body (see Fig. 1).

**In regards to claim 3,** Costello et al. disclose endoscope apparatus, wherein the flexible tube comprises a head portion in which an optical system in an endmost position is incorporated, a curved portion capable of being bent/operated in a remote manner, and an elongated flexible tube portion (see Col. 1, Lines 39-64).

**In regards to claim 5,** Costello et al. disclose endoscope apparatus, wherein the flexible tube comprises the insertion portion, further a universal cable which has flexibility and which transmits an illuminating light and an electric signal, and an intermediate connecting portion which connects the insertion portion to the universal cable (see Figs. 11a-b).

**In regards to claim 7,** Costello et al. disclose endoscope apparatus, wherein the flexible tube comprises the insertion portion, further a universal cable which has flexibility and which transmits an illuminating light and an electric signal, an operation portion which connects the insertion portion to the universal cable and which controls an operation of the insertion portion, and a monitor portion which displays an image photographed by the head portion by operation of the operation portion and image information (see Figs. 1, 11a-b and Col. 4, Lines 1-27).

**In regards to claims 9-10,** Costello et al. disclose endoscope apparatus, wherein the storage section is a container 108 which contains the flexible tube holding member (see Fig. 1).

**In regards to claim 11,** Costello et al. disclose endoscope apparatus, wherein the flexible tube holding member has a rotatable drum 180 or bobbin shape which rotates the flexible tube with a defined diameter (see Figs. 1, 7 and 9).

**In regards to claim 13,** Costello et al. disclose endoscope apparatus, wherein the flexible tube holding member comprises a rotary member around which the flexible tube is wound from a tip side (see Figs. 12a-b).

**In regards to claims 17 and 19,** Costello et al. disclose endoscope apparatus, wherein the flexible tube holding member comprises a first fitting portion which is capable of engaging with and storing the intermediate connecting portion connecting the insertion portion to the universal cable and which has a concave shape (See Fig. 9).

**In regards to claim 21,** Costello et al. disclose endoscope apparatus, wherein the storage section 108 comprises an engagement portion 180 which engages with the flexible tube and engages with the endoscope apparatus main body 106 and is integrally movable (see Fig. 1).

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-3, 5, 7, 9-11, 13, 17, 19, 21 and 23-24 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK *MK*

7/18/7



LINDA C. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700